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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,717	09/30/2003	Paul Blair	20375-042000	3445
20350	7590	08/02/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			REAGAN, JAMES A	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/676,717

Applicant(s)

BLAIR ET AL.

Examiner

James A. Reagan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6-8,12-15 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6-8,12-15 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in response to the amendment filed on 07 June 2005.
2. Claims 3, 5, 9-11 and 16, have been cancelled
3. Claims 1, 2, 4, 6-8, 12-15, 18, 20 and 21 have been amended.
4. Claims 1, 2, 4, 6-8, 12-15, and 17-21 have been examined.

RESPONSE TO ARGUMENTS

5. Applicant's arguments received on 07 June 2005 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole

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would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Mahony "Electronic Payment Systems (c) 1997, in view of Santoro "Australian Postal Corp. Launches Bank Network" (c) 1995.

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim 1:

O'Mahony, in chapters 4 and 5, teaches an electronic payment system wherein a consumer makes payments to a merchant through a third party, thereby disclosing the following limitations:

- *receiving a promise-to-pay record from a lender system operated by the lender at a payment service provider system operated by a payment service provider distinct from the lender, the promise-to-pay record identifying at least a payment amount;*
- *receiving, at the payment service provider system, a record of receipt of a cash payment from the consumer to the payment service provider, the record of receipt identifying a paid amount;*
- *associating the record of receipt of the cash payment with the promise-to-pay record at the payment service provider system;*

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- *sending a notice from the payment service provider system to the lender system, the notice comprising an indicator that the cash payment has been received, the indicator identifying the paid amount; and*
- *initiating, with the payment service provider system, an electronic funds transfer of at least a portion of the paid amount to control of the lender;*

O'Mahony does not disclose that the payment may be made at the payment service provider location. Santoro, however, discloses over the counter bill payments at local bank branches. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the electronic payment system of O'Mahony with Santoro's disclosure of walk-up bill paying because Santoro also discloses that electronic banking and bill paying services are an upgrade to OTC transactions at a bank.

Claims 2, 4, 18, 19:

The combination of O'Mahony/Santoro discloses the walk-up electronic payment system as shown in the rejections of claim 1 above. O'Mahony/Santoro do not specifically disclose:

- *storing a record of the cash payment in a database coupled with the payment service provider system;*
- *the promise-to-pay record includes a transaction identifier;*
- *the record of receipt of the cash payment includes a purported transaction identifier provided by the consumer ;*
- *associating the record of receipt of the cash payment with the promise-to-pay record comprises matching the purported transaction identifier provided by the consumer with the transaction identifier included in the Promise-to-Pay record.*

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- *associating a transaction identifier with the promise-to-pay record with the lender system.*
- *providing the transaction identifier to the customer.*

However, the Examiner takes **Official Notice** that it is old and well known in the financial transaction arts to assign transaction identifiers to payments, keep transaction records, and provide copies of such records to a consumer. Maintaining proper records ensures protection against fraud, theft, and common transactional mistakes.

Claims 6, 7, 8, 20, and 21

The combination of O'Mahony/Santoro discloses the walk-up electronic payment system as shown in the rejections of claim 1 above. O'Mahony/Santoro do not specifically disclose:

- *the promise-to-pay record comprises a time limit, and wherein associating the record of receipt of the cash payment with the promise-to-pay record comprises verifying with the Payment service provider system that the cash payment was made to the payment service provider within the time limit;*
- *sending a request for instructions from the payment service provider system to the lender system if the time limit expires without the payment service provider receiving the cash payment;*
- *sending a request for instructions from the payment service provider system to the lender system if the consumer attempts payment after the time limit expires;*
- *receiving a request for instructions at the lender system from the payment service provider system;*
- *providing the payment service provider system with an instruction in response to the request for instructions from the lender system;*

However, the Examiner takes **Official Notice** that it is old and well known in the financial transaction arts to place time limits, expirations, and delinquency boundaries onto consumer accounts , as well as request continuing guidance regarding delinquent accounts to ensure that the lender's requirements are met. It is long-standing and recognized practice in the collection arts that each promise to pay also includes a date in which the payment is to be received, thereby encouraging debtors to pay as quickly as possible, without further tarnishing their credit or incurring further interviews with the debt collection authority.

Claim 12:

With regard to the limitations of:

- *the promise-to-pay record includes information that identifies the customer; and*
- *associating the record of receipt of the cash payment with the promise-to-pay record comprises verifying a consumer identity through a comparison with the information that identifies the customer in the promise to-pay record;*

O'Mahony in at least section 4.3 discloses PIN verification of a consumer, thereby disclosing verification of consumer identity.

Claim 13:

With regard to the limitations of:

- *receiving, at a lender system operated by the lender, a promise-to-pay a specified payment amount from the customer;*
- *creating a promise-to-pay record with the lender system, the promise-to-pay record including a the specified payment amount and an expiration time;*

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- *transmitting the promise-to-pay record to a payment service provider system operated by payment service provider distinct from the lender,*
- *receiving a notice of payment at the lender system from the payment service provider system if the payment service provider received from the customer a cash payment that equals or exceeds the payment amount prior to the expiration time, and*
- *electronically receiving with the lender system a transfer of at least a portion of the payment amount pursuant to an electronic funds transfer initiated by the payment services provider system;*

See the rejections above.

Claims 14, 15, and 17:

The combination of O'Mahony/Santoro discloses the walk-up electronic payment system as shown in the rejections of claim 1 above. O'Mahony/Santoro do not specifically disclose:

- *updating, with the lender system, the promise-to-pay record to include the notice of payment;*
- *receiving at the lender system a notice of non-effective payment from the payment service provider system;*
- *updating, with the lender system, the promise-to-pay record to include the notice of non-effective payment.*

However, It would have been obvious to one of ordinary skill in the art at the time of the invention to include an update step as well as notifications regarding the current status of an account because this would ensure that payments to delinquent accounts are properly handled.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
9. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **571.272.6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

571-273-8300 [Official communications, After Final communications labeled "Box AF"]

571-273-8300 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

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JAR

27 July 2005

